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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,475	04/20/2006	Sebastijan Bach	2003DE117	5841
25255 7500 08/22/2008 CLARIANT CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 4000 MONROE ROAD CHARLOTTE, NC 28205			EXAMINER	
			CHEUNG, WILLIAM K	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			08/22/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Application No. Applicant(s) 10/533 475 BACH ET AL. Office Action Summary Examiner Art Unit WILLIAM K. CHEUNG 1796 -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS. WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). Status 1) Responsive to communication(s) filed on 21 May 2008. 2a) This action is FINAL. 2b) This action is non-final. 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 4) Claim(s) 1-5.7 and 9-13 is/are pending in the application. 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration. 5) Claim(s) \_\_\_\_\_ is/are allowed. 6) Claim(s) 1-5,7 and 9-13 is/are rejected. 7) Claim(s) \_\_\_\_\_ is/are objected to. 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement. Application Papers 9) The specification is objected to by the Examiner. 10) The drawing(s) filed on is/are; a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abevance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some \* c) None of: Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). \* See the attached detailed Office action for a list of the certified copies not received. Attachment(s)

1) Notice of References Cited (PTO-892)

Paper No(s)/Mail Date 052008

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

Interview Summary (PTO-413)
Paper No(s)/Mail Date.

6) Other:

Notice of Informal Patent Application

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#### DETAILED ACTION

 The examiner acknowledges the argument filed May 21, 2008. Claims 6, 8 have been cancelled. Claims 1-5, 7, 9-13 are pending.

 In view of the amendment filed November 19, 2007, the rejection of 1-7, 9-13 under 35 U.S.C. 112, first paragraph, is withdrawn.

## Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### Claim Rejections - 35 USC § 103

- The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be needlived by the manner in which the invention was made.
- 5. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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Determining the scope and contents of the prior art.

- 2. Ascertaining the differences between the prior art and the claims at issue.
- 3. Resolving the level of ordinary skill in the pertinent art.
- Considering objective evidence present in the application indicating obviousness or nonobviousness.
- 6. Claims 1-5, 7, 9-13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hohner (US 5,998,547) for the reasons adequately set forth from paragraph 8 of the office action of January 4, 2008.

The invention of claims 1-5, 7, 9, 12, 13 relates to a hotmett adhesive comprising between 0.1 and 100% by weight of at least one polyolefin wax consisting of a homopolymer of propylene, or a copolymer of propylene and another olefin selected from the group consisting of ethylene, a branched or unbranched 1-alkene having 4 to 20 carbon atoms, and mixtures thereof, or a copolymer of ethylene and a branched or unbranched 1-alkene having 4 to 20 carbon atoms prepared using a metallocene catalyst and having a dropping point or ring & ball softening point of between 80 and 165°C and a melt viscosity, measured at a temperature 10°C above the dropping or softening point, of not more than 40 000 mPa.s., wherein the at least one polyolefin wax is without polar modification.

The invention of claim 10 relates to a hotmelt adhesive containing between 0.1 and 100% by weight of polyolefin wax consisting of a homopolymer of propylene or a copolymer of propylene and another olefin selected from the group consisting of ethylene, a branched or unbranched 1-alkene having 4 to 20 carbon atoms, and mixtures thereof, or a copolymer of ethylene and a branched or unbranched 1-alkene having 4 to 20 carbon atoms prepared using metallocene catalysts and having a dropping point or ring & ball softening point of between 80 and 185°C and a melt viscosity, measured at a temperature 10°C above the dropping or softening point, of not more than 40 000 mPa.s., wherein the polyolefin waxes are without polar modification.

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The invention of claim 11 relates to a hotmelt adhesive comprising between 0.1 and 100% by weight of a polyolefin wax consisting of a homopolymer of propylene, or a copolymer of propylene and another olefin selected from the group consisting of ethylene, a branched or unbranched 1-alkene having 4 to 20 carbon atoms, and mixtures thereof, or a copolymer of ethylene and a branched or unbranched 1-alkene having 4 to 20 carbon atoms prepared using metallocene catalysts and having a dropping point or ring & ball softening point of between 80 and 165°C and a melt viscosity, measured at a temperature 10°C above the dropping or softening point, of not more than 40 000 mPa.s., wherein the polyolefin wax is without polar modification.

Hohner (col. 2, line 15-51) discloses composition comprising starting polypropylene waxes (without polar modification) prepared using metallocene catalysts having the dropping point or ring & ball softening point and the melt viscosity properties that significantly overlap the dropping point or ring & ball softening point and the melt viscosity properties as claimed.

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15 The synthesis of the unmodified, i.e nonpolar, starting wases by means of exhibits of the Zingler or metallocene type is known from numerous documents. Thus, for example, DE-A-239041 this classes a process by means of which coledus can be polymerized in a direct polymerized to restrict using Zingler catalysis is give homesplaymer or concluding waster. DE-A-3148(22) documents for highly explained they proportion in heavier using training containing catalysis, the same containing catalysis in the same containing catalysis in the same compleme waster and obstantive using metallocuse catalysis (e.g. EP-A-321-852, EP-A-344-264, EP-A-416-506).

Suitable suring uniterable are low molecular weight propylene hospunglymens perspect uning Eighle or metal20 locene catalysts and having noth viscosities, measured at 170° C., of from 20 to \$51,000 mHz.s. The softening points (ring/ball) of such waxes are generally from 90 to 165° C., or generally from 90 to 165° C., or bestide waxes are stoth highly crystalline produces having a high proportion of seatacite or syndicarities strictures and three having a low grystallinity and a predominantly atactic structure. The degree of crosstallinity of peoplytican bormogodymens can be verifed within with timin in a known menure by appropriate selection of the creatilyst used for the polytumerations and by manus of the op polymerization conditions. This applies particularly when using metallicure catalities waters.

Further suitable natring materials are propylene copolytic ways which up repeated sing Zingler or as with occurs catalysis and comprise not only propylene but also varying a standard control of the co

Hohner (col. 8, claims 13-16) clearly claims using the disclosed composition as adhesives. In view of substantially identical material compositions, and dropping point or ring & ball softening point of between 80 and 165°C properties, the examiner has a reasonable basis to believe that the claimed "measured at a temperature 10°C above the dropping or softening point" and the molecular weight properties are inherently possessed in Hohner. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); In re Fitzgerald, 205 USPQ 594 (CCPA 1980).

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Regarding claim 9, Hohner (col. 3, line 35-46) clearly discloses the incorporation of the typical additives or auxiliary into a hotmelt adhesive, such as the hotmelt adhesive disclosed.

Regarding claims 12-13, Hohner (col. 3, line 43-46; col. 6, claims 5-7; col. 7, claim 8; col. 8, claims 13-16) clearly disclose various substrates to be applied with the disclosed hot melt adhesives. Although the disclosed substrates are intended for hot melt adhesives that have been polar modified, nevertheless, Hohner clearly indicates the desirability to use the unmodified hot melt polypropylene adhesives for the various substrates disclosed. It would not be difficult for one of ordinary skill in art to recognize the said desired adhesive applications after reading the disclosure to Hohner.

Applicants must recognize that whether or not Hohner teaches the use unmodified polypropylene waxes to be used as a hotmelt adhesive, Hohner has adequately disclosed the unmodified polypropylene waxes which is identical to the one as claimed. Therefore, the examiner has a reasonable basis to believe that the polypropylene waxes disclosed in Hohner is capable to be used as a hotmelt adhesive in view of the substantially identical composition disclosed and as claimed. The rejection set forth is proper.

#### Response to Arguments

 Applicant's arguments filed May 21, 2008 have been fully considered but they are not persuasive. Applicants continue to argue that Hohner teaches polypropylene waxes

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modified with polar groups. Therefore, applicants believe that Hohner is inadequate to be used as a reference for the rejection set forth. However, the examiner disagrees.

Applicants must recognize that the claimed invention is a hotmelt adhesive characterized by a composition comprising between 0.1 and 100% by weight of at least one polyolefin wax without polar modification. According to the composition teachings in Hohner, Hohner (col. 2, line 15-51) clearly discloses composition comprising starting materials such as polypropylene waxes that are without polar modification, prepared using metallocene catalysts having the dropping point or ring & ball softening point and the melt viscosity properties that significantly overlap the dropping point or ring & ball softening point and the melt viscosity properties as claimed. Although Hohner relates to the modification of polypropylene waxes disclosed, applicants must recognize that the starting polypropylene waxes are compositionally identical to the adhesive invention as claimed. In view of the substantially identical composition as claimed and the composition disclosed in the starting materials of Hohner, the examiner has a reasonable basis that the starting materials (polypropylene waxes) as taught in Hohner inherently possessed the capability to be used as a hotmelt adhesive. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); In re Fitzgerald, 205 USPQ 594 (CCPA 1980).

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#### Conclusion

 THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM: 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William K Cheung/ Primary Examiner, Art Unit 1796

William K. Cheung, Ph. D. Primary Examiner August 16, 2008